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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF
YUAN ET AL.
APPLICATION NO: 09/248,158
FILED: FEBRUARY 9, 1999
FOR: DIRECT ADSORPTION SCINTILLATION ASSAY FOR MEASURING ENZYME ACTIVITY AND ASSAYING BIOCHEMICAL PROCESSES

Art Unit: 1627
Examiner: GARCIA, MAURIE E.

#35

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR 1.181

Sir:

This is a petition to review the Examiner's decision in the Advisory Action to not enter Appellants amendment mailed July 18, 2003 (see MPEP 1002.02(c)(g); MPEP 714.19; MPEP 714.12).

Please charge Deposit Account No. 19-0134 in the name of Novartis in the amount of $130 in payment of the fee pursuant to 37 CFR 1.17(h) for submission of a petition. The Commissioner is hereby authorized to charge any additional fees that may be required, or to credit any overpayment, to Deposit Account No. 19-0134 in the name of Novartis. An additional copy of this paper is here enclosed.

Alternatively, this is a petition to withdraw the Final Rejection because said rejection was premature (see MPEP 1002.02(c)(a); MPEP 706.07(c)).

The Examiner raised in the Final Rejection (mailed May 19, 2003) an issue regarding the phrase "can be stimulated" in Applicants Claim 1 (see paragraph 11 of the Final Rejection). This issue had not been raised earlier during the lengthy prosecution of this application.

It is Applicants position that the Examiner's reasoning is erroneous regarding this issue and that no amendment is necessary. That is, in the context of Applicants' Claim 1, one skilled

in the art would view said claim has having the identical meaning and scope regardless of whether the term "is" or "can be" is used. Nevertheless, in an effort to advance prosecution and to appease the Examiner, Applicants attempted to amend Claim 1 to change "can be" to "is" in Applicants' AMENDMENT AFTER FINAL REJECTION, mailed July 18, 2003. In the Advisory Action mailed August 5, 2003, the Examiner refused entry of this amendment. Such amendment clearly renders the issue raised in paragraph 11 of the Final Rejection moot, therefore, Applicants do not understand why the Examiner has refused to enter the amendment.

As stated above, either use of the term "is" or "can be" in Claim 1 provides the same meaning and scope to the claim. Therefore, the highlighted last sentence of paragraph 4 of the Advisory Action is clearly irrelevant because the proposed amendment does not restrict the scope of the claim as alleged by the Examiner.

Moreover, the indefiniteness issue raised in paragraph 6 of the Advisory Action clearly lacks merit. The Examiner in paragraph 3 of the Advisory Action admits that the proposed amendment " does set forth the limitation with somewhat more particularity". If the proposed amendment in the Examiner's opinion sets forth the limitation with more particularity, how can it also be rendered more indefinite? The answer is that it cannot.

It is understood that Applicants do not have the unrestricted right to have an amendment entered after final rejection (37 CFR 1.116). However, as stated in MPEP 714.12:

> "Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered."

Since the proposed amendment eliminates an entire issue, clearly the claims would be at least in better form for appeal.

Furthermore, the issues in paragraph 11 of the Final Rejection were raised for the first time in the Final Rejection. It would be manifestly unfair to not allow Applicants to address this point in prosecution before appeal, i.e., be forced to address this issue for the first time on appeal. Accordingly, in the event that this petition to enter the amendment after Final Rejection is denied, then, in the alternative, it is requested that this paper be considered a Petition to Withdraw the Finality of Rejection, because making this rejection final was premature.

Respectfully submitted,

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